REMARKS

Status Of Application

Claims 1-20 are pending in the application; the status of the claims is as follows:

Claims 1, 2, 6-8, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,867,741 to Maruyama et al. ("Maruyama et al. US 5,867,741") in view of U.S. Patent No. 5,764,285 to Ochi et al. ("Ochi et al. US 5,764,285").

Claims 3-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, as applied to claims 1 and 10 above, and further in view of U.S. Patent No. 5,946,028 to Ishikawa ("Ishikawa US 5,946,028").

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, as applied to claim 1 above, and further in view of U.S. Patent No. 4,553,170 to Aoki et al. ("Aoki et al. US 4,553,170").

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, and further in view of applicants' prior art.

Claims 10-17 are allowed.

Claim Amendments

Claims 1 and 18 have been amended to more particularly point out and distinctly claim the inventions. These changes do not introduce any new matter.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1, 2, 6-8, and 20 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, is respectfully traversed based on the following.

Maruyama et al. US 5,867,741 shows a camera combining film photography capability with electronic photography capability. The image is formed using image pick-up lens 1. The image is then partially reflected by fixed half mirror 4 on to area sensor 15 via image-forming lens 14. The image formed on area sensor 15 is processed by signal processor 22. The resulting image data may be stored in non-volatile memory 26 or displayed on LCD 23 (col. 4, lines 50-54).

A portion of the image passes through half mirror 4 and is reflected off movable half mirror 5 through various components to finder eyepiece 31. With movable half mirror 5 in the down position, a portion of the image passes through movable half mirror 5, off of sub-mirror 32, through separator optical system 16 to line sensor 17. When movable half mirror 5 is raised, the image passes directly through shutter 6 to film 7. When the movable half mirror 5 is raised, no image is reflected to either eyepiece 31 or line sensor 17.

Ochi et al. US 5,764,285 shows an electronic camera (1b of Figure 5) including a line sensor 11 used in combination with an area sensor 12. Line sensor 11 is driven by scan motor 23 through line scanning mechanism 20b so that the line sensor can capture the entire image (col. 5, lines 58-67). To overcome the limitations of the area sensor 12 and line sensor 11, the two are synthesized (col. 5, lines 29-41).

In contrast to the cited references, claim 1 includes:

> a semitransparent mirror which rotates about an axis in a direction perpendicular to the optical axis of the taking lens so as to move between an advanced position intersecting at an inclination an optical path from the

> taking lens to the image sensor for photographing in a first photographic mode where a first portion of the light transmitted by the taking lens is reflected by the semitransparent mirror and a second portion of the light transmitted by the taking lens forms an image on the image sensor, and a retracted position removed from the optical path for photographing in a second photographic mode where substantially all of the light transmitted by the taking lens forms an image on the image sensor; and

When the movable half mirror 5 of Maruyama et al. US 5,867,741 is in the retracted position, no light from image pick-up lens 1 goes to line sensor 17. Thus, Maruyama et al. US 5,867,741 does not show or suggest "a semitransparent mirror" having "a retracted position removed from the optical path for photographing in a second photographic mode where substantially all of the light transmitted by the taking lens forms an image on the image sensor." In addition, none of the other cited references shows or suggests this limitation. To support a *prima facie* case for obviousness, the cited references, singularly or in combination, must show every limitation of the claim (MPEP §2143.03). Therefore, claim 1 is patentably distinct from the cited references. Claims 2 and 6-8 are dependent upon claim 1, and thus include every limitation of claim 1. Therefore claims 2 and 6-8 are also patentably distinct from the cited references.

Also in contrast to the cited references, claim 20 includes a digital camera:

> wherein said digital camera is controllable under a first photographic mode wherein said optical element is set at the advanced position for photography, and a second photographic mode wherein said optical element is set at the retracted position for photography, and the optical path lengths from the taking lens to said image sensor are equalized in the first photographic mode and the second photographic mode by moving the image sensor.

The cited references do not show or suggest a camera where "the optical path lengths" between the first and second modes are equalized "by moving the image sensor." Therefore, the cited references do not show or suggest every limitation of claim 20, and thus do not support a *prima facie* case for obviousness of claim 20.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 6-8, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, be reconsidered and withdrawn.

The rejection of claims 3-5 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, as applied to claims 1 and 10 above, and further in view of Ishikawa US 5,946,028, is respectfully traversed based on the following.

Claims 3-5 are dependent upon claim 1 and thus include all limitations of claim 1. As noted above, Maruyama et al. US 5,867,741 and Ochi et al. US 5,764,285 do not show or suggest "a semitransparent mirror" having "a retracted position removed from the optical path for photographing in a second photographic mode where substantially all of the light transmitted by the taking lens forms an image on the image sensor." Ishikawa US 5,946,028 also does not show or suggest this limitation. Therefore, the combination of these references does not support a *prima facie* case for obviousness of claim 1. Because claims 3-5 include all of the limitations of claim 1, they are also not obvious over the combination of Maruyama et al. US 5,867,741, Ochi et al. US 5,764,285 and Ishikawa US 5,946,028 and are patentably distinct from the cited references.

Accordingly, it is respectfully requested that the rejection of claims 3-5 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285 et al. US 5,764,285, as applied to claims 1 and 10 above, and further in view of Ishikawa US 5,946,028, be reconsidered and withdrawn.

The rejection of claim 9 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, as applied to claim 1 above, and further in view of Aoki et al. US 4,553,170, is respectfully traversed based on the following.

Claim 9 is indirectly dependent upon claim 1 and thus includes all limitations of claim 1. As noted above, Maruyama et al. US 5,867,741 and Ochi et al. US 5,764,285 do not show or suggest "a semitransparent mirror" having "a retracted position removed from the optical path for photographing in a second photographic mode where substantially all of the light transmitted by the taking lens forms an image on the image sensor." Aoki et al. US 4,553,170 also does not show or suggest this limitation. Therefore, the combination of these references does not support a *prima facie* case for obviousness of claim 1. Because claim 9 includes all of the limitations of claim 1, it is also not obvious over the combination of Maruyama et al. US 5,867,741, Ochi et al. US 5,764,285 and Aoki et al. US 4,553,170 and is patentably distinct from the cited references.

Accordingly, it is respectfully requested that the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, as applied to claim 1 above, and further in view of Aoki et al. US 4,553,170, be reconsidered and withdrawn.

The rejection of claims 18 and 19 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, and further in view of applicants' prior art, is respectfully traversed based on the following.

In contrast to the cited references, claim 18 includes:

> a semitransparent mirror which rotates about an axis in a direction perpendicular to the optical axis of the taking lens so as to move between an advanced position intersecting at an inclination the optical path from the taking lens to the image sensor so that a first portion of the light transmitted by the taking lens is reflected by the semitransparent mirror and a second portion of the light transmitted by the taking lens forms an image on the image sensor, and a retracted position removed from the optical path so that substantially all of the light transmitted by the taking lens forms an image on the image sensor; ...

When the movable half mirror 5 of Maruyama et al. US 5,867,741 is in the retracted position, no light from image pick-up lens 1 goes to either line sensor 17 or is

reflected by half mirror 5. Thus, Maruyama et al. US 5,867,741 does not show or suggest "a semitransparent mirror" having "a retracted position removed from the optical path so that substantially all of the light transmitted by the taking lens forms an image on the image sensor." None of the other cited references shows or suggests this limitation. To support a *prima facie* case for obviousness, the cited references, singularly or in combination, must show every limitation of the claim. Therefore, claim 18 is patentably distinct from the cited references. Claim 19 is dependent upon claim 18, and thus includes every limitation of claim 18. Therefore, claim 19 is also patentably distinct from the cited references.

Accordingly, it is respectfully requested that the rejection of claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama et al. US 5,867,741 in view of Ochi et al. US 5,764,285, and further in view of applicants' prior art, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By:_____

Douglas A. Sorensen
Registration No. 31,570
Attorney for Applicants

DAS/llb:bar/llb:jkk
SIDLEY AUSTIN BROWN & WOOD LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3482
Main: (214) 981-3300
Facsimile: (214) 981-3400
December 22, 2005

DA1 336860v.5